

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Ferree

Serial No.: 10/652,842

Group No.: 3738

Filed: August 29, 2003

Examiner: T. Sweet

For: CEMENTED ARTIFICIAL DISC REPLACEMENTS

APPELLANT'S REPLY BRIEF

Mail Stop APPEAL BRIEF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

In response to the Examiner's Answer mailed June 23, 2008, Applicant submits herewith its Reply Brief, which is being submitted to address new issues raised in the Examiner's Answer. In the Response to Arguments section of the Examiner's Answer, the Examiner states that Buettner-Janz is "fully capable" of being used as claimed (Examiner's Answer, bottom of page 5). In other words, the Examiner contends that that Buettner-Janz is *inherently* capable of being used as claimed. However, "[i]nherency . . . may not be established by probabilities or possibilities.

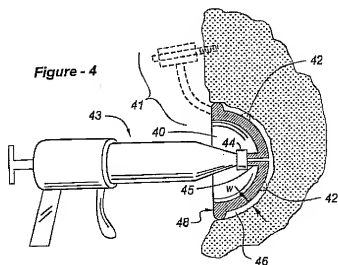
The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). *See also Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BPAI 1986) ("[T]he examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art" before the burden is shifted to the applicant to disprove the inherency.).

In this case, the Examiner has not provided evidence or scientific reasoning to show that the Buettner-Janz apparatus is "fully capable" of being used as claimed by Appellant. Indeed, since Appellant's claims now include the limitation of "a path to fill the cavity with cement after the component is installed," the Examiner's argument that the Buettner-Janz apparatus meets the limitation "when the anchors are not fully imbedded," (Answer, top of page 6), runs counter to Appellant's recitation of "after the component is installed." To any person of skill in the art of orthopaedics, "after the component is installed" can only mean "when the anchors *are* fully imbedded." Thus, the Examiner

has failed to show that Buettner-Janz expressly or inherently meets all the limitations of the instant claims.

With regard to the Buettner-Janz/Masini combination, the Examiner argues that “the teaching of Masini to use an injector (43) and a path (45) are an obvious modification as a substitute for filling the cavity with cement prior to implantation.” (Examiner’s Answer, middle of page 6). Appellant respectfully disagrees.

Figure 4 of Masini has been reproduced below to illustrate Masini’s use of an injector (43) and a path (45):



Again, the Examiner has not provided evidence or scientific reasoning to show why the cement injector 43 of Masini is “fully capable” of being used to cement the device of Buettner-Janz. In fact, Figure 4 shows the injector 43 “coupled via connector 44 to an apertured stem 45, enabling cement to enter into and fill a cavity 46 created between the unit 40 and the surface of the bone.” The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

John G. Posa
Reg. No. 37,424
Gifford, Krass, Sprinkle, Anderson & Citkowski, P.C.
PO Box 7021
Troy, MI 48007-7021
(734) 913-9300

Date: August 25, 2008